

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q86324

Noboru YAMAJI, et al.

Appln. No.: 10/525,015

Group Art Unit: 1654

Confirmation No.: 5025

Examiner: Andrew D. KOSAR

Filed: February 17, 2005

For: AN AGENT FOR INHIBITING ARTICULAR CARTILAGE EXTRACELLULAR
MATRIX DEGRADATION

**PETITION TO WITHDRAW FINALITY
UNDER 37 C.F.R. § 1.181**

ATTN: Technology Director

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant submits that the final Office Action dated November 8, 2007, improperly has been made final and thus respectfully solicits withdrawal of the finality of the Office Action.

Specifically, the Examiner has raised a new ground of rejection based on a newly cited reference. The Examiner states that the rejection is necessitated by the amendments to the claims, particularly the introduction of new claim 18. The Examiner also states that Watkins, a new reference may be appropriately applied to claims 11 and 13-17, which were not amended substantively. Contrarily, the MPEP § 706.07(a) states:

a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art . . . of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art (emphasis added).

In the present case, new claim 18 was added, but claims 11 and 13-17 were not substantively amended. Claims 11 and 13-15 were not amended at all and claims 16 and 17 were amended by inserting the article “a” before “histone deacetylase –inhibiting compound” merely to correct an informality, which did not necessitate the new grounds of rejection. Despite this, the Examiner issued a Final Office Action, dated November 8, 2007, in which the Examiner propounded a new rejection against claims 11 and 13-17 based on Watkins as mentioned above. For the first time in the Final Office Action dated November 8, 2007, the Examiner cited this new reference against claims that were not substantively amended as discussed above. Thus, Applicants’ amendments have not necessitated this new ground of rejection.

Since the Examiner applied the newly cited reference to claims not substantively amended, i.e., claims 11 and 13-17, Applicants submit that the final rejection is improper.

Further, since Applicants are limited in the action that can be taken after a final rejection as a matter of right, Applicants submit that making the rejection final is improper as a procedural matter for the reasons set forth above.

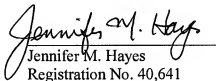
For the reasons discussed above, Applicant requests that the finality of the Office Action be withdrawn.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,


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CUSTOMER NUMBER

Date: January 8, 2008